

**REMARKS**

This is a full and timely response to the non-final Office Action (Paper No. omitted) mailed by the U.S. Patent and Trademark Office on September 23, 2004. Claims 1-35 remain pending in the present application. Claims 1, 3, 4, 10, 12, 13, 19, 23, 26 and 27 are amended. Applicants respectfully submit that support for the amendments can be found in the specification at least on page 6, lines 30-32, page 8, line 29 and on page 9, line 7. In view of the foregoing amendments and following remarks, reconsideration and allowance of the present application and claims are respectfully requested.

**Double Patenting**

Claims 1-9 are objected to under 37 C.F.R. § 1.75 as being a substantial duplicate of claims 10-18. Applicants acknowledge the rejection and will respond upon allowance of either claims 1-9 or 10-18, pursuant to M.P.E.P. § 706.03(k).

**Rejections Under 35 U.S.C. § 103**

Claims 1-18 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2002/0141095 to Yahiro in view of U.S. Patent Application Publication No. 2003/0212759 to Wu. Applicants will also assume that claims 19-35 are rejected under the same grounds as claims 1-18 and will respond accordingly. If Applicants have misinterpreted the Examiner's intent, Applicants respectfully request clarification in a subsequent action.

For a claim to be properly rejected under 35 U.S.C. § 103, "[t]he PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted). Further, to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion

to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed Cir. 1992).

With regard to claims 1-18, it is alleged in the Office Action that:

Regarding claim 1, Yahiro teaches a method of marking data objects on an electronic device to be transferred by the electronic device, the method comprising the steps of:

- a) presenting a user interface of the electronic device [0031];
- b) applying a set of criteria to the data object to determine if the data object is capable of being transferred [Abstract; 0013-0014] and
- c) providing an indicator if the data object is capable of being transferred by the electronic device [Abstract].

However, Yahiro does not explicitly teach presenting a data object on the user interface of the electronic device although he discloses an interface of a transmitting device to another device [figure 2]. Wu teaches presenting a data object on the user interface of the electronic device (abstract, figures 1 and 3). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to employ a data object on the user interface of the electronic device in order to allow users to select data object to be transferred, therefore ensuring that the user will transfer the intended data object, thus minimizing transfer errors.

*Yahiro* discloses a communication device comprising a unit that is configured to make a communication with another communication device. The communication device includes means for detecting the data size of the communication that is to be made with the other communication device, a means for determining a total communication data size from the data size detected by the communication device, means for determining if the total communication data size exceeds a predetermined use limit, and means for restricting the communication when it is determined that the total communication data size exceeds the predetermined use limit. *See, Yahiro*, paragraph 14. *Yahiro* continues, stating that “the control unit 7 can compare the use limit with the total data size exchanged via communications or the use limit time and the total communication time, and can activate/cancel use restriction of the wireless unit 4.” *See, Yahiro*, paragraph 35. The system described by *Yahiro* is used to prevent the communication of data from one device to another when one or more different use parameters are exceeded. For example, the embodiment shown in Fig. 3 of *Yahiro* restricts communication of the wireless unit when a total communication data size is exceeded. *See, Yahiro*, paragraphs 39-45. In the embodiment shown in Fig. 4 of *Yahiro*, restriction of the use of the wireless unit is provided when the total communication time is exceeded. *See, Yahiro*, paragraphs 50-56. In another embodiment shown in Fig. 5 of *Yahiro*, restriction of the use of the wireless unit is activated when the total communication data size exceeds memory capacity. *See, Yahiro*, paragraphs 57-62. From this it is abundantly clear that the system disclosed by *Yahiro* merely restricts data communication between two devices when a certain parameter is exceeded, and does not necessarily communicate with a user of the device. Importantly, nowhere does *Yahiro* disclose, teach or suggest presenting a data object *to a user* on the user interface and indicating *to the user* whether that data object is capable of being transferred to another communication device before a transmission is made.

*Wu* discloses a method for providing advertising to a handheld computer operable to connect to a network. The handheld computer includes a screen for displaying visual content received from the network and is configured for playing an audio message associated with the visual content. The method includes receiving a request for content from the handheld computer and associating an advertisement with the request for content. The requested content is sent to the handheld computer for display on the screen of the computer and the associated advertisement is sent to the computer for playing over an audio output device of the handheld computer. *See, Wu, Abstract.* *Wu* continues, stating that the invention “generally comprises computer code that receives a request for content from the handheld computer and associates an advertisement with the request for content.” *See, Wu, paragraph 8.* *Wu* continues, stating that “[t]he product further includes computer code that sends the requested content to the handheld computer and sends the associated advertisement to the handheld computer for playing over an audio output device of the handheld computer and a computer readable medium that stores the computer codes.” *See, Wu, paragraph 8.*

With reference to Fig. 1, *Wu* discloses that “a handheld device 20 is shown displaying a Web page and playing an audio advertisement while the Web page is displayed on a screen 31 of the handheld device. According to a preferred embodiment, audio advertisements or ‘audio banners’ are pushed to a handheld device’s audio channel, leveraging its built-in voice facility. In this way, users can access Web content on a full size screen while listening to any accompanying audio advertisements.” *See, Wu, paragraph 20.* Essentially, the system disclosed by *Wu* allows audio banners to be downloaded to the handheld device 20 with minimal impact on visual content. *See, Wu, paragraph 20.* *Wu* further states that “the Web content displayed on the handheld computer is information on a particular stock and the audio advertisement is for a stock Web site. Advertisers may select specific Web pages for their audio advertisements to be played in conjunction with the page being

displayed. The audio advertisement of FIG. 1 is sent with a Web page displaying stock quotes, since viewers of this page typically would be interested in a stock related Web site.” *See, Wu*, paragraph 20.

Applicants agree with the statement on page 3 of the Office Action that “Yahiro does not explicitly teach presenting a data object on the user interface of the electronic device.” However, Applicants respectfully disagree with the statement in the Office Action that “Wu teaches presenting a data object on the user interface of the electronic device (abstract, figures 1 and 3).” Applicants respectfully submit that nowhere does the proposed combination disclose, teach or suggest at least “providing an indicator *to the user* if the data object is capable of being transferred by the electronic device *before a transmission is made*,” as recited in independent claim 1. Neither does the proposed combination disclose, teach or suggest at least “providing an indicator *to the user* if the data object is incapable of being transferred by the electronic device *before a transmission is made*,” as recited in independent claim 10.

Applicants respectfully disagree with the statement in the Office Action that “[i]t would have been obvious to one of ordinary skill in the art to employ a data object on the user interface of the electronic device in order to allow users to select data object to be transferred, therefore ensuring that the user will transfer the intended data object, thus minimizing transfer errors.” Applicants respectfully submit that nowhere does the proposed combination disclose, teach or suggest providing any sort of indicator to the user that a data object is capable or incapable of being transferred by the electronic device. Applicants respectfully submit that *Wu* fails to cure the deficiencies in *Yahiro* in that nowhere does *Wu* disclose, teach or suggest providing an indicator associated with a data object, to indicate to the user whether the data object is capable or incapable of being transferred by the electronic device.

Applicants respectfully disagree with the statement on page 3 of the Office Action, regarding claim 2, that “Yahiro teaches the method of claim 1, wherein presenting a data object on the user interface of the electronic device comprises

displaying the data object on a display of the electronic device [figures 1, ref. 10].” Applicants respectfully submit that reference numeral 10 in *Yahiro* refers to various information processing apparatuses 10 such as a portable telephone, MP3 player, and the like, and does not refer to displaying a data object on a display of the electronic device. *See, Yahiro*, paragraph 25.

Furthermore, Applicants respectfully submit that on page 3, paragraph 3, the Office Action states that “*Yahiro* does not explicitly teach presenting a data object on the user interface of the electronic device.” Therefore, Applicants respectfully submit that the Office Action is contradictory when it also states on page 3, paragraph 4 that *Yahiro* teaches the method of claim 1, “wherein presenting a data object on the user interface of the electronic device comprises displaying the data object on a display of the electronic device.”

Similarly, with regard to claim 3, Applicants do not understand how, if the Office Action says that *Yahiro* does not teach presenting a data object on the user interface of the electronic device, it can be stated that *Yahiro* teaches the method of claim 1, “wherein if the data object is capable of being transferred, further comprising the steps of; e) transferring the data object [abstract].”

Applicants also respectfully disagree with the statement on page 4 of the Office Action, regarding claim 4, that “*Wu* teaches adding the data object to a modifiable list of data objects selected for transfer [0005].” Applicants respectfully submit that nowhere, in paragraph 5, or elsewhere, does *Wu* disclose, teach or suggest adding the data object to a modifiable list of data objects selected for transfer, as recited in claim 4.

With regard to the statement on page 5 of the Office Action, regarding claim 6, that “*Yahiro* teaches the method of claim 5, wherein the predetermined transfer limitations comprise file size limitations, confidentiality limitations, and file type limitations [0039-0044],” Applicants respectfully submit that nowhere does *Yahiro* disclose, teach or suggest confidentiality limitations and file type limitations.

Accordingly, Applicants respectfully submit that independent claims 1 and 10 are allowable over *Yahiro* in view of *Wu*, and furthermore, that dependent claims 2-9 and 11-18 are allowable for at least the reason that they depend either directly or indirectly from allowable independent claims. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted).

### **Claims 19-25**

With regard to claim 19, it is stated in the Office Action that:

Yahiro teaches a method of marking a plurality of data objects on an electronic device for transfer, comprising the steps of:

- a) presenting a first data object [abstract];
- b) applying a set of criteria to the data object to determine if the first data object is capable of transfer [Abstract; 0013-0014] and
- c) providing an indicator if the first data object is capable of being transferred by the electronic device [abstract; 0045].

However, Yahiro fails to explicitly teach d) allowing user to select the first data object for transfer; e) adding the selected data object to a list of data objects for transfer; f) presenting a next data object; and g) repeating steps b) through e) with said next data object.

Wu teaches d) allowing user to select the first data object for transfer [0020]; and e) adding the selected data object to a list of data objects for transfer [0020]. Although Wu does not explicitly disclose f) and g), one of ordinary skill in the art would have recognized that when sending multiple data objects, it is well known in the art that subsequent data objects are presented and that the steps of b) to e) are repeated.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teaching of Yahiro with the teaching of Wu in order to allow the data object to be selected for transfer in order to ensure that the user will transfer the intended data object, thus minimizing transfer errors.

Applicants respectfully submit that the proposed combination fails to disclose, teach or suggest at least “providing an indicator *to a user* if the first data object is capable of being transferred by the electronic device *before a transmission is made*,” as recited in claim 19. Further, Applicants respectfully submit that the proposed combination fails to disclose, teach or suggest at least “allowing the user to select the first data object for transfer,” “adding the selected data object to a list of data objects for transfer” and “presenting a next data object.” Applicants respectfully disagree with the statement in the Office Action that “[i]t would have been obvious to one of ordinary skill in the art to combine the teachings of Yahiro with the teachings of Wu in order to allow the data object to be selected for transfer in order to ensure that the user will transfer the intended data object, thus minimizing transfer errors.” Applicants respectfully submit that the proposed combination fails to disclose, teach or suggest at least the steps mentioned above.

Accordingly, Applicants respectfully submit that independent claim 19 is allowable over *Yahiro* in view of *Wu*, and furthermore, that dependent claims 20-25 are allowable for at least the reason that they depend either directly or indirectly from an allowable independent claim. *In re Fine, supra*.

### Claims 26-35

With regard to claim 26, it is stated in the Office Action that:

Yahiro teaches an apparatus capable of transferring one or more data objects, the apparatus comprising:

- a) a memory device for containing a program module and at least one data object [figure 1];



b) a user interface [figure 1]; and

c) a processing unit coupled to the memory device and the user interface, the processing unit being operative in response to the instructions of the program module to:

i) present a data object on a user interface of the electronic device [abstract];

ii) apply a set of criteria to the data object to determine if the data object is capable of being transmitted [0039-0044]; and

iii) provide an indicator if the data object is capable of being transmitted [0045].

With respect to independent claim 26, Applicants respectfully submit that the proposed combination fails to disclose, teach or suggest at least “a processing unit coupled to the memory device and user interface, the processing unit being operative in response to the instructions of the program module to: ... iii) provide an indicator *to the user* if the data object is capable of being transmitted *before a transmission is made,*” as recited in independent claim 26. Applicants respectfully submit that *Wu* fails to cure the deficiencies of *Yahiro*, in that the above-mentioned feature is neither disclosed, taught nor suggested by the proposed combination.

Accordingly, Applicants respectfully submit that independent claim 26 is allowable over *Yahiro* in view of *Wu*, and furthermore, that dependent claims 27-35 are allowable for at least the reason that they depend either directly or indirectly from an allowable independent claim. *In re Fine, supra*.

**No Motivation to Combine *Yahiro* and *Wu***

Applicants respectfully submit that there is no motivation to combine the teachings of *Yahiro* and *Wu* to arrive at Applicants’ invention. “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed

invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.” *ACS Hospital Systems, Inc., v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Further, “[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination.” *In re, Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

Applicants respectfully submit that there is nothing in *Yahiro* or *Wu* that would motivate one having ordinary skill in the art to combine these references to arrive at the data object mark and send procedure. Furthermore, there is no motivation to combine *Yahiro*’s communication restriction means with *Wu*’s method for providing visual and corresponding audible advertising to a handheld computer, to arrive at Applicants’ invention. Applicants’ invention provides a visual indication that a data object is suitable or non-suitable for transmission to another communication device. There is nothing in either *Yahiro* or *Wu* that would lead one having ordinary skill in the art to combine *Yahiro* and *Wu* to arrive at Applicants’ invention, which includes the above-described indicator. Indeed, Applicants respectfully submit that by disclosing a communication restriction means, *Yahiro* teaches away from Applicants’ invention and from *Wu*’s visual and audible advertisement system.

Further, neither *Yahiro* or *Wu* provide either a reasonable expectation of success of combining the references to provide a visual indication to a user that a data object is suitable or non-suitable for transmission to another communication device, or show any relevance to the problem solved by Applicants’ invention. Specifically, Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness because the Office Action has not pointed out the specific teachings in either *Yahiro* or *Wu* that would motivate one having ordinary skill in the art to combine the references to arrive at Applicants’ invention.

Therefore, Applicants respectfully submit that the proposed combination is improper in that one having ordinary skill in the art would not be led to combine the teachings of *Yahiro* and *Wu* to arrive at Applicants' invention.

Further, for at least the reasons stated above, the proposed combination of *Yahiro* and *Wu* fails to disclose, teach or suggest the elements mentioned above in Applicants' independent claims.

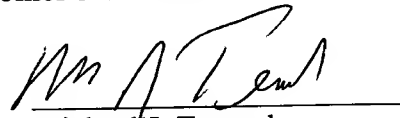
**CONCLUSION**

For at least the foregoing reasons, Applicants respectfully request that all outstanding rejections be withdrawn and that all pending claims of this application be allowed to issue. If the Examiner has any comments regarding Applicants' response or intends to dispose of this matter in a manner other than a notice of allowance, Applicants request that the Examiner telephone Applicants' undersigned attorney.

Respectfully submitted,

**NEEDLE & ROSENBERG, P.C.**  
**Customer No. 23859**

By:



Michael J. Tempel  
Registration No. 41,344